## REMARKS

Claims 1-23 are all the claims currently pending in the present application.

**Claims 19 and 22**

Claims 19 and 22 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Winters, U.S. Patent No. 4,007,330 ("Winters").

Applicant submits that Winters fails to disclose or suggest stopping operation of at least one delay profile circuit on the basis of a comparison result, as claimed. Regarding this limitation, the Examiner asserts that the stopping operation is an inherent feature of the Winters apparatus because "by comparing the largest correlation value with a threshold, i.e. the largest correlation being selected by the peak selection circuit and fed from this circuit to a threshold detector circuit would only allowed an output to occur only when the largest correlation exceeds a predetermined level (col. 7 lines 32-36), therefore operation of the circuit would stop." (Office Action, p. 2-3).

Applicant acknowledges that Winters describes that a peak selection circuit "selects the largest sum from the three correlation circuits 29, 30, and 31." (Col. 7, lns. 21-23). Applicant further acknowledges that the "the selected peak is fed from the correlation circuit 35 to a threshold detection circuit 36 which allows an output to occur at a terminal 36 only when the largest sum selected exceeds a predetermined level." (Col. 7, lns. 33-37). However, Applicant notes that evidence of inherency in a reference "must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so

recognized by persons of ordinary skill."[1] Applicant further submits that "inherency may not be established by probabilities or possibilities."[2] The Examiner appears to assert that because the threshold detector of winters only outputs a correlation signal when the selected sum is larger than a predetermined level, it is inherent that when the selected sum is not larger than the predetermined level, the operation of one or more of the delay circuits 16, 17, and 18 is stopped. However, as would have been clear to one of skill in the art, stopping the operation of one or more delay circuits is by no means a necessary result of the threshold detector not outputting a correlation signal. Rather, there is no disclosure or suggestion in Winters of stopping the operation of the delay circuits. Winters specifically describes that the delay circuits continuously compare a number of demodulated sample bits with a replica of the transmitted signal code, and that as the samples move through the delay circuits, comparisons are made of *each* sample (col. 6, lns. 28-42), suggesting that there is no stopping of the operation of the delay circuits. Applicant submits, therefore, that rather than stopping the operation of any of the delay circuits of Winters upon a determination that the selected peak fails to exceed a predetermined threshold, the threshold detector merely fails to transmit a correlation signal at that time.

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[1] *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

[2] *Id.* (*citing In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981) (*quoting Hansgirg v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939))); *see also Scaltech Inc. v. Retec/Tetra L.L.C.*, 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

Applicants notes that even if Winters could have equally been used or made with only two possibilities, a patent claim which claims one of the two possibilities will not be anticipated because that limitation was not "necessarily" present in the Winters disclosure.[3]

Thus, in view of at least the above, Applicant submits that Winters fails to anticipate Claims 19 and 22 and respectfully requests that the rejection of these claims be reconsidered and withdrawn.

**Claims 1 and 2**

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Klang et al., U.S. Patent No. 6,330,271 ("Klang"), in view of Hulbert at al., U.S. Patent No. 5,793,796 ("Hulbert").

Regarding Claim 1, Applicant submits that the cited combination of references fails to teach or suggest stopping the operation of at least one delay profile circuit. The Examiner asserts that Hulbert col. 10, lns. 26-28 and lns. 31-36 teaches this limitation. (Office Action, page 4). However, contrary to the assertion of the Examiner, Hulbert teaches no such limitation. The referenced portion of Hilbert describes a method of achieving initial synchronization by applying a search strategy to the bank of correlators, wherein, when "at least one correlator with sufficient energy is found, the primary search strategy is stopped." As would have been clearly understood by one of skill in the art, stopping a search strategy fails to teach or suggest stopping the

[3] *See Finnigan Corp. v. I.T.C.*, 51 U.S.P.Q.2d 1001, 1009-10 (Fed. Cir. 1999) (holding that a prior art reference that disclosed a set-up for performing only resonance or nonresonance ejection was insufficient to show, clearly and convincingly, that nonresonance ejection was inherently taught by the prior art reference).

operation of a delay circuit, as claimed. Further, there is no other portion of Hulbert or Klang which teaches or suggest stopping the operation of a delay circuit.

Further, regarding Claim 2, Applicant submits that the cited combination of reference fails to teach or suggest delay profile circuits for receiving signals from a plurality of CDMA transmitters or performing any action during a handover operation of switching from one of a plurality of CDMA transmitters to another CDMA transmitter. Klang is specifically directed to a CDMA receiver which receives a radio signal from a single source, which has been "reflected and scattered off various objects, giving rise to multi-path propagation," (Col. 1, lns. 48-49), and neither Klang nor Hulbert teaches or suggest any handover operation.

Therefore, in view of at least the above, Applicant submits that Claims 1 and 2 are patentable over any reasonable combination of Klang and Hulbert and respectfully requests that the rejection of these claims be reconsidered and withdrawn.

**Claims 3-18, 20-21, and 23**

Claims 15-18 and 23 are allowed. (Office Action, p. 5). The Examiner indicates that Claims 3-14, 20, and 21 contain allowable subject matter and would be allowed if rewritten into independent form including the limitations of the claims from which they depend. Applicant respectfully requests that the rewriting of these claims be held in abeyance until the Examiner has considered the above arguments with respect to Claims 1 and 19.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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